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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/534,433	03/23/2000	David L. Patton	80521F-P	1516
1333	7590	05/28/2004	EXAMINER HENDERSON, MARK T	
PATENT LEGAL STAFF EASTMAN KODAK COMPANY 343 STATE STREET ROCHESTER, NY 14650-2201			ART UNIT 3722	PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20040524

Application Number: 09/534,433
Filing Date: March 23, 2000
Appellant(s): PATTON, DAVID L.

Frank Pincelli

For Appellant

MAILED

MAY 28 2004

GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 11, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 12, 14, 18-23, 25, 29-34 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,919,730

GASPER ET AL

7-1999

Missouri Dept. of Conservation "Welcome Hummingbirds by fueling up the Feeders" St. Louis Post Dispatch, Edition: FIVE STAR, Sec: St Charles, Page: 06

Charles Verge, "Canada Post announces 1996 stamp program", Ottawa Citizen, Final Edition, (December 30, 1995), pp. G2.

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 12, 14, 18-23, 25 and 29-34 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 20.

(11) Response to Argument

Appellant's arguments filed on March 11, 2004 have been fully considered, but they are not persuasive.

In response to Claims 12, 14, 18, 23, 25, 29 and 34, wherein the Appellant states that the Gasper et al reference is "totally apart and distinct from the invention" and "is not related in any way to that being an official postal stamp as taught by Applicant", the examiner submits that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the Gasper et al reference discloses a document which is referred to "any type of sheet media bearing, or capable of bearing any type of visible information", wherein the "information is either pictorial or graphical in form including, but not limited to text, sketches, computer graphics, pictorial images... and other forms of two-dimensional art." Therefore, the document or media of the Gasper et al reference is capable of being a postage stamp. Gasper et al further discloses a document or media comprising a visible first indicia, and a second indicia made using ink that can be seen when viewed under UV or infrared light, not visible under normal viewing conditions, and incapable of being scanned for reproduction. However, Gasper et al does not disclose wherein the first indicia being a unique ID which identifies that the limited edition postal stamp is one out of a predetermined limited number; and a third indicia that is not visible under normal viewing conditions,

incapable of being scanned for reproduction, and wherein the ink can be viewed under UV or infrared light. In this regard, the examiner also submits that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the St. Louis Dispatch article and the Ottawa Citizen article are recited for disclosing stamp medias or documents (whether they are postal or not) that are sequentially numbered and labeled (and in the case of the Ottawa Citizen, can be used for official postal purposes). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gasper et al's document or media to be in the form of a stamp comprising unique indicia as taught by the St Louis Dispatch for the purpose of providing a limited edition stamp media for postal purposes.

In response to appellant's arguments the Gasper et al reference does not disclose or teach "providing of the second indicia which is not visible under normal viewing conditions, the examiner submits that the Gasper et al reference does indeed disclose the provision of a second indicia which is "substantially undetectable by casual observation under normal conditions of the document". This means that under normal viewing conditions, an end user cannot detect (by eye) the second indicia without the use of some external scanning device. Therefore, the second indicia can indeed be scanned for viewing. The examiner further submits that "scanning for viewing" is not

equivalent to "scanning for reproduction". Due to the appellant's claim limitation, the examiner interpreted the limitation of the second indicia as "not capable of being scanned for reproduction" as not being able to produce an exact document copy as the original, however, it can still be scanned for viewing. Appellant's now argues that "not capable of being scanned for reproduction" means that the second indicia should not be capable of being scanned at all, however, that is not the case according to the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

In regards to Appellant's arguments that the prior art references do not teach the provision of a third indicia for identifying a printer or location where the limited edition stamp was printed, the examiner submits that it would be obvious to one having ordinary skill in the art at the time the invention was made to include as many types of indicia having the same characteristics as those of the "second indicia" as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to place any number of indicia on the stamp substrate, since applicant has not disclosed the criticality of having a particular number, that such a modification would produce no new or unexpected results for patentability, and the invention would operate equally as well with any number of added indicia. Furthermore, a recitation of the intended use (in which the indicia would be used for identifying a printer or location where the limited edition postal was printed) of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

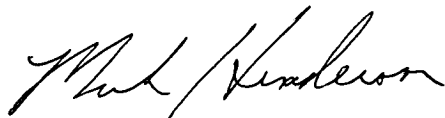
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claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, the indicia of the Gasper et al reference, is capable of being used for identifying a printer or stamp printing location.

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For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Mark Henderson
Examiner
Art Unit 3722

May 24, 2004

Conferees



Andrea L. Wellington
Examining Supervisor
Art Unit 3722



Derris Banks
Examining Supervisor
Art Unit 3712

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201